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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,148	10/10/2001	Toshiyuki Kudo	213911US2PCT	2536

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EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,148

Applicant(s)

KUDO, TOSHIYUKI

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/13/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Dziewit et al (4981370) in view of Graziano et al (5191613).

Regarding claim 1, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for creating and authenticating an electronic contract including a digital signature and a third party trustee substantially as claimed. The differences between the above and the claimed invention is the use of an explicit safekeeping. It is noted that it is believed that the authentication are functionally equivalent to the claimed limitations. Graziano et al (See Fig. 3-6, Cols. 13-16) show and electronic contract safekeeping. It would have been

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obvious to the person having ordinary skill in this art to provide a similar arrangement for Dziewit et al because the authenticated electronic contracts are conventional functional equivalents with respect to the claim limitations. Regarding confirmation limitations of claim 2, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party trustee which is a functional equivalent of the claim limitations. Regarding agreement limitations of claim 3, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party which is a functional equivalent of the claim limitations. Regarding exhibition limitations of claim 4, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating (including display) and authenticating an electronic contract including a digital signature identification and a third party which are the functional equivalents of the claim limitations. Regarding the agreement limitations of claim 5, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and

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authenticating an electronic contract including a digital signature identification and a third party which is a functional equivalent of the claim limitations since all ATM's are tethered to a communication and power line. Regarding safekeeping server limitations of claim 6, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party that is a functional equivalent of the claim limitations since the third party functions as the safekeeping server. Regarding the plurality of server limitations of claim 7, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party that is a functional equivalent of the claim limitations since the third party trustees (col. 13, line 9) functions as the safekeeping servers. Regarding the plurality of server limitations of claim 8, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party that is a functional equivalent of the claim limitations since the third party trustees (col. 13, line 9) functions as the

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safekeeping servers. Regarding claim 9, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for creating and authenticating an electronic contract including a digital signature and a third party trustee substantially as claimed. The differences between the above and the claimed invention is the use of an explicit safekeeping. It is noted that it is believed that the authentication are functionally equivalent to the claimed limitations. Graziano et al (See Fig. 3-6, Cols. 13-16) show and electronic contract safekeeping. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Dziewit et al because the authenticated electronic contracts are conventional functional equivalents with respect to the claim limitations. Regarding claim 10, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a means for creating and authenticating an electronic contract including a digital signature and a third party trustee substantially as claimed. The differences between the above and the claimed invention is the use of an explicit safekeeping. It is noted that it is believed that the authentication are functionally equivalent to the claimed limitations. Graziano et al (See Fig. 3-6, Cols. 13-16) show and electronic contract safekeeping. It would have been obvious to the person having ordinary skill in this art to provide a similar

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arrangement for Dziewit et al because the authenticated electronic contracts are conventional functional equivalents with respect to the claim limitations. Regarding claim 11, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a means for creating and authenticating an electronic contract including a digital signature and a third party trustee substantially as claimed. The differences between the above and the claimed invention is the use of an explicit safekeeping. It is noted that it is believed that the authentication are functionally equivalent to the claimed limitations. Graziano et al (See Fig. 3-6, Cols. 13-16) show an electronic contract safekeeping. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Dziewit et al because the authenticated electronic contracts are conventional functional equivalents with respect to the claim limitations. Regarding exhibition limitations of claim 12, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating (including display) and authenticating an electronic contract including a digital signature identification and a third party which are the functional equivalents of the claim limitations. Regarding safekeeping server limitations of claim 13, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60)

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disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party that is a functional equivalent of the claim limitations since the third party functions as the safekeeping server. Regarding medium limitations of claim 14, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party that is a functional equivalent of the claim limitations since the functions caused may be implemented by software(See Col/ 8, lines 15-50). Regarding medium limitations of claim 15, Dziewit et al (See abstract, Figs. 3-5, Col. 2, lines 10-55, Col. 4, lines 5-15, Col. 8, lines 15-65, Col 13, lines 5-60) disclose a method for negotiating and authenticating an electronic contract including a digital signature identification and a third party that is a functional equivalent of the claim limitations since the functions caused may be implemented by software(See Col/ 8, lines 15-50).

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number (703) 305-1837. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768.

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Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
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or faxed to (703)872-9306

Hand delivered responses should be brought to Crystal Park
V, 2451 Crystal Drive, Arlington, Virginia, Seventh
Floor(Receptionist).

Any inquiry of a general nature or relating to the status of
this application or proceeding should be directed to the
Technology Center 3600 Customer Service Office whose telephone
number is (703) **308-4177**.

Information regarding the status of an application may be
obtained from the Patent Application Information Retrieval (PAIR)
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access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

J. Corzalla
J. Corzalla
Patent Examiner
April 2002